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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,101	11/21/2001	Patrick W.K. Lee	032775-090	9339

7590 06/03/2003

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P.O. Box 1404  
Alexandria, VA 22313-1404

EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
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1636

12

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/989,101	LEE ET AL.
	Examiner Terry A. McKelvey	Art Unit 1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 36-60 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 36-60 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36-60 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new rejection necessitated by the applicant's amendment to the claims filed 3/24/03.

Applicant's amendment filed 3/24/03 canceled all of the claims and added new claims drawn to a method of treating a rasmiediated proliferative disorder in an animal comprising administering to said animal an effective amount of one or more reoviruses. The applicant indicated that support for the claimed subject matter is at page 7, line 15-28, for example. However, this section only provides support for treating neoplasms in animals, and not the broader concept of

proliferative disorders, which encompasses other proliferative diseases in addition to neoplasms. Nowhere in the application as filed is there a description of treating the broader range of conditions encompassed by proliferative disorders. Accordingly, the addition of the new claims drawn to treating proliferative disorders constitutes new matter.

***Double Patenting***

Claims 36-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,261,555. This rejection is maintained for reasons of record set forth in Paper No. 9, filed 10/03/02, extended to new claims 36-60 as necessitated by the applicant's amendment filed 3/24/03). Applicants' arguments filed 3/24/03 have been fully considered but they are not deemed to be persuasive.

***Response to Arguments***

The applicant argues that the amendment adding new claims drawn to substantially the same subject matter but of a different scope than the original claims presumably obviates the double-patenting rejections. This argument is not persuasive because the claims still encompass treating a Ras-mediated

neoplasm in an animal (and adding other proliferative disorders) by administering one or more reoviruses. Accordingly, the instant application claims remain either anticipated by or would have been obvious over, the patent claims.

Claims 36-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,110,461. This rejection is maintained for reasons of record set forth in Paper No. 9, filed 10/03/02, extended to new claims 36-60 as necessitated by the applicant's amendment filed 3/24/03). Applicants' arguments filed 3/24/03 have been fully considered but they are not deemed to be persuasive.

#### ***Response to Arguments***

The applicant argues that the amendment adding new claims drawn to substantially the same subject matter but of a different scope than the original claims presumably obviates the double-patenting rejections. This argument is not persuasive because the claims still encompass treating a Ras-mediated neoplasm in an animal (and adding other proliferative disorders) by administering one or more reoviruses. Accordingly, the

instant application claims remain either anticipated by or would have been obvious over, the patent claims.

Claims 36-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 and 28-32 of U.S. Patent No. 6,136,307. This rejection is maintained for reasons of record set forth in Paper No. 9, filed 10/03/02, extended to new claims 36-60 as necessitated by the applicant's amendment filed 3/24/03). Applicants' arguments filed 3/24/03 have been fully considered but they are not deemed to be persuasive.

**Response to Arguments**

The applicant argues that the amendment adding new claims drawn to substantially the same subject matter but of a different scope than the original claims presumably obviates the double-patenting rejections. This argument is not persuasive because the claims still encompass treating a Ras-mediated neoplasm in an animal (and adding other proliferative disorders) by administering one or more reoviruses. Accordingly, the instant application claims remain either anticipated by or would have been obvious over, the patent claims.

Claims 36-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,344,195. This rejection is maintained for reasons of record set forth in Paper No. 9, filed 10/03/02, extended to new claims 36-60 as necessitated by the applicant's amendment filed 3/24/03). Applicants' arguments filed 3/24/03 have been fully considered but they are not deemed to be persuasive.

***Response to Arguments***

The applicant argues that the amendment adding new claims drawn to substantially the same subject matter but of a different scope than the original claims presumably obviates the double-patenting rejections. This argument is not persuasive because the claims still encompass treating a Ras-mediated neoplasm in an animal (and adding other proliferative disorders) by administering one or more reoviruses. Accordingly, the instant application claims remain either anticipated by or would have been obvious over, the patent claims.

***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant does submit a paper by fax, the original

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signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached on (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**Terry A. McKelvey, Ph.D.  
Primary Examiner  
Art Unit 1636**

June 1, 2003